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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GORDON K. CHANG, ROBERT W. HARBISON,
RICHARD J. BARRY, MING C. LO,
and STEPHEN R. RAAB

Appeal 2009-006418
Application 10/086,602
Technology Center 2400

Before: ROBERT E. NAPPI, KALYAN K. DESHPANDE, and BRUCE R.
WINSOR, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

The Appellants seek review under 35 U.S.C. § 134 of a rejection of claims 20-27 and 29-38, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

The Appellants invented an apparatus and method for integrated voice gateway. Specification 1:8.

An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below [bracketed matter and some paragraphing added]:

21. A communication system comprising:

[1] a public switched telephone (PST) network;

[2] an internet protocol (IP) network;

[3] a plurality of gateway networks coupled to the PST network and the IP network, each of the plurality of gateway networks configured to route a telephone call over the PST network or the IP network; and

[4] an enterprise directory server coupled to the plurality of gateway networks, the enterprise directory server comprising an enterprise directory that is a directory of named objects, including users, network devices and network services and having an extensible schema configured to provide data to support routing of telephone calls.

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jul. 21, 2008) and Reply Brief ("Reply Br.," filed Nov. 7, 2008), and the Examiner's Answer ("Ans.," mailed Oct. 15, 2008), and Final Rejection ("Final Rej.," mailed Dec. 20, 2007).

REFERENCES

The Examiner relies on the following prior art:

Curry	US 6,078,582	Jun. 20, 2000
Guy	US 6,298,057	Oct. 2, 2001
Rainis	US 6,310,873	Oct. 30, 2001
Krishnaswamy	US 6,909,708	Jun. 21, 2005

REJECTIONS

Claim 20 stands rejected under 35 U.S.C §101 as being directed towards non-statutory subject matter. Ans. 3.

Claims 21, 27, and 29-31 stand rejected under 35 U.S.C §102(e) as being anticipated by Krishnaswamy. Ans. 3.

Claim 22-26 stands rejected under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Guy. Ans. 5.

Claim 32-37 stands rejected under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Curry. Ans. 6.

Claims 20 and 38 stand rejected under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Rainis. Ans. 9.

ISSUES

The issue of whether the Examiner erred in rejecting claim 20 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter turns on whether claim 20 recites a tangible structure.

The issue of whether the Examiner erred in rejecting claims 21, 27, and 29-31 under 35 U.S.C §102(e) as being anticipated by Krishnaswamy turns on whether Krishnaswamy describes an enterprise directory.

The issue of whether the Examiner erred in rejecting claims 22-26 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Guy turns on whether the Appellants' arguments in support of claim 21 are found persuasive.

The issue of whether the Examiner erred in rejecting claims 32-37 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Curry turns on whether the Appellants' arguments in support of claim 21 are found persuasive.

The issue of whether the Examiner erred in rejecting claims 20 and 38 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Rainis turns on whether the Examiner has failed to provide specific evidence of a motivation to combine Krishnaswamy and Rainis.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Facts Related to the Prior Art

Krishnaswamy

01. Krishnaswamy is directed to a system, method, and article of manufacture for using the Internet as the communication backbone of a communication system architecture while maintaining a rich array of call processing features.
Krishnaswamy 1:11-14.
02. Krishnaswamy describes a directory service that uniquely identifies internet telephone users using an email address.

Krishnaswamy 81:2-5. Users register with the directory service and make their location (or IP address) known. Krishnaswamy 81:5-9. Other information submitted by users include name, email address, IP address (for fixed location computers), site code, account code, usual internet access point, and other relevant information. Krishnaswamy 106:25-29.

03. The typical steps to receive a call include the system sending a “ring” message to the IP address of the user. Krishnaswamy 108:65-67 and 109:1-2. The user then accepts the call and communicates using telephony software until either user breaks the communication by sending a disconnect message. Krishnaswamy 109:6-27.

Guy

04. Guy is directed to transmitting aural information through a wide area network. Guy 1:19-21.

Curry

05. Curry is directed to arrangements for public telecommunications systems to provide long distance telephone service over the Internet. Curry 1:5-7.

Rainis

06. Rainis is directed to a system that manages the transport of voice of the Internet. Rainis 1:7-9.

ANALYSIS

Claim 20 rejected under 35 U.S.C §101 as being directed towards non-statutory subject matter²

The Examiner found that claim 20 recites a data structure of a database, which is not within the four statutory categories of patent eligible subject matter. Ans. 3. The Examiner specifically found that claim 20 only recites a database and therefore is not a process, the database fails to perform any useful, concrete, and tangible result and therefore is not a machine, and the database is an abstract construct and therefore is not a product, machine, or composition of matter. Ans. 3. The Appellants contend that claim 20 recites a data structure on a tangible medium and produces functional advantages and therefore recites patentable subject matter. App. Br. 7.

We agree with the Appellants. Claim 20 recites “at least one tangible medium having an enterprise directory ...embodied thereon.” As such, claim 20 recites a tangible structure and therefore recites the use of a machine. As such, the Examiner’s rationale for rejecting claim 20 under 35 U.S.C. § 101 is in error.

² We have decided the appeal before us. However, should there be further prosecution of these claims; the Examiner's attention is directed to recently issued guidance from the Director as follows below in the citations to the Federal Register and Official Gazette. Should there be further prosecution with respect to claim 20, the Examiner's attention is directed to *In re Nuijten*, 500 P.3d 1346 (CAFC 2007), and 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); Subject Matter Eligibility of Computer Readable Media.

Claims 21, 27, and 29-31 rejected under 35 U.S.C §102(e) as being anticipated by Krishnaswamy

The Appellants contend that Krishnaswamy only describes a database and fails to describe an enterprise directory as required by the claims. App. Br. 8-19 and Reply Br. 1-3. The Examiner found that Krishnaswamy describes a directory server that includes a directory. Ans. 4, 12.

We disagree with the Appellants. The Examiner found that Krishnaswamy describes a directory service, not a database. Ans. 4, 12. The Appellants have presented several arguments distinguishing a database from an enterprise directory, including providing several references around the time of the claimed invention. App. Br. 10-12. The Appellants further present a claim construction of an “enterprise directory” to distinguish this term from a database. App. Br. 13-19. Assuming, *arguendo*, a directory is distinguished from a database, these arguments fail to distinguish Krishnaswamy’s description of directory services from the claimed invention. As such, the Appellants’ arguments regarding Krishnaswamy describing a database and not an enterprise directory are not persuasive since the Examiner does not rely on any description of a database in the rejection.

The Appellants further contend that Krishnaswamy describes “directory services” that are strictly concerned with call routing and fail to describe a directory of named objects, including users, network devices, and network services. App. Br. 12-13. We disagree with the Appellants. Krishnaswamy describes directory services that manage objects, including user’s name, email address, IP address (for fixed location computers), site code, account code, usual internet access point, and other relevant information. FF 02. That is, the directory services are concerned with

named objects, including users, network devices, and network services in addition to call routing. The Appellants also argue that although Krishnaswamy describes directory services for call routing, the directory services are not “enhanced” with an extensible schema to provide data to support call routing. App. Br. 12-13. However, as discussed *supra*, Krishnaswamy describes information in the directory services used to route calls. In this manner, the data is enhanced such that call routing can be performed. The Appellants have not provided any further rationale to distinguish the claimed invention from Krishnaswamy. As such, the Appellants’ arguments are not found to be persuasive.

*Claim 22-26 rejected under 35 U.S.C §103(a) as being unpatentable
over Krishnaswamy and Guy*

The Appellants contend that claims 22-26 are patentable for the same reasons asserted in support of claim 21. App. Br. 19. We disagree with the Appellants. The Appellants’ arguments were not found to be persuasive *supra* and are not found to be persuasive here for the same reasons.

*Claim 32-37 rejected under 35 U.S.C §103(a) as being unpatentable
over Krishnaswamy and Curry*

The Appellants contend that claims 32-37 are patentable for the same reasons asserted in support of claim 21. App. Br. 19. We disagree with the Appellants. The Appellants’ arguments were not found to be persuasive *supra* and are not found to be persuasive here for the same reasons.

*Claims 20 and 38 rejected under 35 U.S.C §103(a) as being
unpatentable over Krishnaswamy and Rainis*

The Appellants contend that claims 20 and 38 are patentable for the same reasons asserted in support of claim 21. App. Br. 20. We disagree with the Appellants. The Appellants' arguments were not found to be persuasive *supra* and are not found to be persuasive here for the same reasons.

The Appellants further contend that the Examiner has failed to provide any evidence that a person with ordinary skill in the art would have been motivated to combine Krishnaswamy and Rainis and therefore the Examiner is employing impermissible hindsight reasoning. App. Br. 20-21.

We disagree with the Appellants. As discussed in the *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007),

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

In pertinent part, the Examiner's analysis need not seek out precise teachings. The Examiner found that a person with ordinary skill in the art would have been motivated to combine Rainis' description of a method and system of storing information into an x.500 database such as LDAP to Krishnaswamy in order to reduce the cost of telephone calls (Ans. 10) and therefore has set forth the inferences and creative steps that a person with ordinary skill in the art would employ. As such, we are not persuaded that the Examiner has erred.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claim 20 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

The Examiner did not err in rejecting claims 21, 27, and 29-31 under 35 U.S.C §102(e) as being anticipated by Krishnaswamy.

The Examiner did not err in rejecting claims 22-26 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Guy.

The Examiner did not err in rejecting claims 32-37 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Curry.

The Examiner did not err in rejecting claims 20 and 38 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Rainis.

DECISION

To summarize, our decision is as follows.

- The rejection of claim 20 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter is not sustained.

- The rejection of claims 21, 27, and 29-31 under 35 U.S.C §102(e) as being anticipated by Krishnaswamy is sustained.
- The rejection of claims 22-26 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Guy is sustained.
- The rejection of claims 32-37 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Curry is sustained.
- The rejection of claims 20 and 38 under 35 U.S.C §103(a) as being unpatentable over Krishnaswamy and Rainis is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

msc